

Serial No.: 10/773,242
Docket No.: 956-1001
Amendment dated January 23, 2007
Reply to the Office Action of September 27, 2006

REMARKS

Introduction

Upon entry of the foregoing amendment, claims 1-20 (as amended) and new claims 21-26 are pending in this application. Claims 3 and 14 have been amended. With regard to claim 14, the term "wherein" has been added where appropriate. Further, the title has been amended. Also, paragraphs [0010], [0012], [0030], [0032], [0050], [0051], [0055], and [0059] have been amended.

No new matter is being introduced.

In response to the statement in the Office Action (at page 3, lines 8-10) that "[t]he amendment must be accompanied by a Statement ... stating that the material being inserted ... contains no new matter", Applicant notes that in the Amendment filed on May 2, 2006, Applicant expressly stated at page 9 under the Remarks section "No new matter is being presented."

In view of the further following remarks, reconsideration and allowance of all the pending claims are requested.

Objections

Drawings

The Office Action has objected to the drawings for not illustrating labels 520 and 520a recited in paragraph [0032] at page 5 of the specification originally filed. In addition the Office Action has objected to the drawings for not illustrating space 710a.

In response, Applicant has amended paragraph [0032] to remove the labels "520" and "520a" and replace the same with labels "21" and "11" as noted below.

With regard to paragraph [0032], the phrase "the . . . therapy components 520 and 520a provided" is replaced with the phrase "the . . . therapy components 21 (foot pressure plate) and 11 (spinal corrector)". (Emphasis added.) Support for a foot pressure plate 21 and a spinal corrector 11 is found in the specification originally filed at page 13, original claim 11, reciting "a spinal corrector and a foot pressure plate" illustrated – as spinal corrector 11 and foot pressure plate 21 – in FIGS. 1, 2, and 4 together with relevant written description provided at page 5, last

Serial No.: 10/773,242
Docket No.: 956-1001
Amendment dated January 23, 2007
Reply to the Office Action of September 27, 2006

sentence of paragraph [0030], at page 8 in paragraphs [0049], [0050], [0052], [0054], for example, and elsewhere in the specification originally filed.

Also, with regard to space 710a (recited in the specification at page 8, paragraph [0054]), Applicant respectfully submits that FIG. 1 illustrates space 710a at the right and left ends thereof.

As the labels "520" and "520a" are removed and space 710a is illustrated in FIG. 1, Applicant respectfully submits that no replacement drawings are needed. Applicant, therefore, requests reconsideration and withdrawal of all objections to the drawings including those objections noted at page 2 of the Office Action.

Specification

The Office Action has objected to the specification for the reasons noted at page 3. Applicant respectfully submits the following remarks with respect to each ground of objection.

"PERSONAL THERMOTHERAPY INSTRUMENT"

The Examiner has objected to Applicant's title indicating that it is "not descriptive." While Applicant respectfully traverses this ground of objection, in the interest of expediting prosecution, Applicant has amended the title to "PERSONAL THERMOTHERAPEUTICAL SYSTEM" wherein at least "THERMO" refers to heat or to warm etc., which is denoted by the use of the term "foment," which has the following connotation according to Answers.com (on the internet):

fo·ment (fō-měnt')

tr.v., -ment·ed, -ment·ing, -ments.

1. To promote the growth of; incite.

2. To treat (the skin, for example) by fomentation.

{Middle English fomenten, to apply warm liquids to the skin, from Old French fomenter, from Late Latin fōmentāre, from Latin fōmentum, poultice, from fovēre, to warm.}
[(Underlining emphasis added.)]

Serial No.: 10/773,242
Docket No.: 956-1001
Amendment dated January 23, 2007
Reply to the Office Action of September 27, 2006

Thus, Applicant respectfully submits that "PERSONAL THERMOTHERAPEUTICAL SYSTEM" is fully described throughout the specification with each instance of the use of "foment" (or slight variation thereof). Also, the phrase "PERSONAL THERMOTHERAPEUTICAL SYSTEM" is expressly recited at page 5, paragraph [0032] of the specification originally filed.

Moreover, the applied reference, namely, issued U.S. Pat. No. 6,656,138 B2 to Kim (hereinafter "Kim") contains a title of "MULTIFUNCTION HYPERTHERMO-THERAPEUTICAL APPARATUS" which recites language similar to Applicant's objected title of "PERSONAL THERMOTHERAPY INSTRUMENT" which was perfectly acceptable to the U.S. Patent & Trademark Office (USPTO) when it issued the Kim patent. (Emphasis added.) Certainly, if the title of the applied Kim reference is descriptive, it is difficult to understand why Applicant's original title is also not sufficiently descriptive when taken in conjunction with Applicant's remarks herein.

However, in order to help expedite prosecution and allowance of the instant application, Applicant has amended the title to "PERSONAL THERMOTHERAPEUTICAL SYSTEM," which is as acceptable as the title of the Kim patent accepted by the USPTO when it issued the Kim patent.

In view of Applicant's foregoing amendment to the title made to expedite prosecution without introducing new matter, Applicant respectfully requests withdrawal of any objection to the title because both the original title as well as the new title are fully descriptive.

"electric field parts"

The Office Action has objected to the use of the phrase "electric field parts" for the reasons noted at page 3 of the Office Action. In order to help expedite prosecution and allowance of the instant application, Applicant responds by amending the relevant phrase as indicated below.

In claim 3, the phrase "electric field parts" is amended to "electric motor parts" to provide improved clarity. (Emphasis added.) Support for such amendments to claim 3 is found in the specification originally filed where reference is made, for example, to motor 12 at page 2,

Serial No.: 10/773,242
Docket No.: 956-1001
Amendment dated January 23, 2007
Reply to the Office Action of September 27, 2006

paragraph [0005], line 2 (e.g., “motor 12”) and elsewhere throughout the specification and drawings originally filed.

With regard to paragraph [0012], the phrase “electric field parts” is likewise amended to “electric motor parts”. (Emphasis added.) The above-noted support for replacing “field” with “motor” (in relation to claim 3) is equally applicable to this amendment to paragraph [0012].

The foregoing amendment is made to provide improved clarity without introducing new matter.

“does not have a specific foldable providing function”

The Office Action has objected to the use of the phrase “does not have a specific foldable providing function” for the reasons noted at page 3 of the Office Action. In order to help expedite prosecution and allowance of the instant application, Applicant responds by amending the relevant phrase as indicated below.

With regard to paragraph [0010], the phrase “does not have a specific foldable providing function” is amended to “does not have a specific collapsible folding function” as noted herein. (Emphasis added.) Support for the phrase “collapsible folding” is found in the specification in the Abstract, line 2 thereof, reciting “A personal thermotherapy instrument . . . is provided with a collapsible folding” (Emphasis added.) Also, a comparison of original FIG. 8 to original FIG. 9 illustrates an example of a collapsible folding function. Original claim 1 also recites “collapsible folding.” Additional support is found elsewhere in the specification and drawings originally filed.

The foregoing amendment is made to provide improved clarity without introducing new matter.

“circuit relationship and peripheral technique”

The Office Action has objected to the use of the phrase “circuit relationship and peripheral technique” for the reasons noted at page 3 of the Office Action. In order to help expedite prosecution and allowance of the instant application, Applicant responds by amending the relevant phrase as indicated below.

Serial No.: 10/773,242
Docket No.: 956-1001
Amendment dated January 23, 2007
Reply to the Office Action of September 27, 2006

With regard to paragraph [0030], the sentence "A detailed description will be omitted since the invention has a generally used circuit relationship and peripheral technique by operating . . . " is amended to "A detailed description will be omitted since the invention has a generally used feature of pressurizing and fomenting the spine of the user by operating" (Emphasis added.) Support for the introduced phrase in the amended sentence is found in the specification originally filed at page 2, paragraph [0008] reciting "This thermotherapy system A . . . has an advantage of pressurizing and fomenting the spine of the user" taking into account that the term "fermenting" was typographically corrected to "fomenting" in the Amendment filed on May 2, 2006. (Emphasis added.) Additional support is found in the specification at page 11, paragraph [0070] reciting "In addition, the thermotherapy instrument is used to pressurize and foment . . ." as noted in the specification taking into consideration that the phrase "is used to pressurize and foment" replaced "to pressurize and ferment" in the Amendment filed on May 2, 2006 to a correct typographical and to recite proper grammatical English usage. (Emphasis added.)

The foregoing amendment is made to provide improved clarity without introducing new matter.

"holes 630 are in plate 600, not plate 800"

The Office Action has objected to the use of the phrase "fastening holes 530 and 630 (FIG. 4) fastened and fixed onto the fastening plates 800 and 800a are each formed on the base plates 510 and 510a" for the reasons noted at page 3 of the Office Action. In order to help expedite prosecution and allowance of the instant application, Applicant responds by amending the relevant phrase as indicated below.

With respect to paragraph [0055], the phrase "fastening holes 530 and 630 (FIG. 4) fastened and fixed onto the fastening plates 800 and 800a are each formed on the base plates 510 and 510a" is amended to "fastening holes 530 and 630 (FIG. 4), to be fastened and fixed onto the fastening plates 800 and 800a, are each formed on the base plates 510 and 510a" consistent with the description provided at page 9 of the specification originally filed at paragraphs [0057], [0059] and [0060] reciting, in relevant part, the following:

Serial No.: 10/773,242
Docket No.: 956-1001
Amendment dated January 23, 2007
Reply to the Office Action of September 27, 2006

[0057] Subsequently, the first assemblies 500 and 500a each fasten and fix the fastening hole 530 formed in the base plates 510 and 510a to the fastening plate 800 of the inner frames 230 and 330, respectively. [(Underlining emphasis added.)]

* * *

[0059] At this time, the fastening holes 630 formed in the side plates 620 and 620a are each screw combined with a respective fastening plate 800a of the outer frames 220 and 320, then the second assemblies 700 and 700a are each combined with the [middle] assemblies 600 and 600a respectively as one body to then be fastened and fixed to the folding type frame B. [(Underlining emphasis added.)]

[0060] If an after-sale service case occurs under the above described combined state, a worker unfastens a fastening bolt screw-combined with the fastening hole 800a of the side plates 620 and 620a and separates the second assemblies 700 and 700a from the outer frames 220 and 320. [(Underlining emphasis added.)]

The foregoing amendment is made to provide improved clarity without introducing new matter.

“medium”

In paragraphs [0050], [0051], [0055] and [0059], the term “medium” is replaced with the term “middle” with respect to assemblies 600 and 600a. (Emphasis added.)

In particular, with regard to paragraphs [0050] and [0051], the phrase “The medium assembly 600” is amended to “The middle assembly 600” to correct an obvious typographical error. (Emphasis added.) Support for a “middle assembly 600” is found in the specification originally filed at least at page 8, paragraph [0048] reciting “the middle assemblies 600 and 600a” and elsewhere throughout the specification. (Emphasis added.)

Likewise, with regard to paragraphs [0055] and [0059], the phrase “the medium assemblies 600 and 600a” is amended to “the middle assemblies 600 and 600a” to correct a similar obvious typographical error. (Emphasis added.) Support for a “middle assemblies 600 and 600a” is found in the specification originally filed at least at page 8, paragraph [0048] reciting

Serial No.: 10/773,242
Docket No.: 956-1001
Amendment dated January 23, 2007
Reply to the Office Action of September 27, 2006

“the middle assemblies 600 and 600a” and elsewhere throughout the specification. (Emphasis added.)

The foregoing amendment is made to provide improved clarity without introducing new matter.

Summary regarding objections to Title, Specification, and Drawings

In view of the foregoing amendments to the , title and relevant specification paragraphs, Applicant respectfully submits that all objections have been fully addressed without introducing new matter. Accordingly, Applicant respectfully requests reconsideration and withdrawal of each objection of record.

Rejection under 35 USC § 112

Claim 3 has been rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for reciting “electric field parts”. As already noted, the phrase “electric field parts” is amended to “electric motor parts.”

In view of this amendment, Applicant respectfully requests reconsideration and withdrawal of each rejection under 35 U.S.C. § 112, second paragraph.

Rejections under 35 U.S.C. § 103

Claims 1, 2, 4, 8, 10-17 and 20 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Kim in view of U.S. Patent 3,884,160 to Gutierrez (hereinafter “Gutierrez”) for the reasons noted at pages 4-5 of the Office Action.

Claim 3 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Kim in view of Gutierrez as applied to claim 2 above and further in view of U.S. Patent No. 5,974,979 to Grady et al. (hereinafter “Grady”) for the reasons noted at pages 5-6 of the Office Action.

Claims 5 and 19 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Kim in view of Gutierrez as applied to claims 4 and 14 above and further in view of U.S. Patent 4,202,018 to Lehmann (hereinafter “Lehmann”) for the reasons noted at page 6 of the Office Action.

Serial No.: 10/773,242
Docket No.: 956-1001
Amendment dated January 23, 2007
Reply to the Office Action of September 27, 2006

Claims 6, 7, 9 and 18 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Kim in view of Gutierrez as applied to claims 4 and 14 above and further in view of U.S. Patent 5,283,919 to Grant (hereinafter "Grant") for the reasons noted at pages 6-7 of the Office Action.

Applicant respectfully traverses each of these rejections under 35 U.S.C. § 103(a) for at least the reasons noted below. In particular, as noted above, the Kim reference is the primary reference combined with the various secondary references (Gutierrez, Grady, Lehmann, or Grant) used to assert the obviousness rejection under 35 U.S.C. § 103(a). Thus, each obviousness rejection requires applying Kim as the primary reference.

However, as explained in detail below, it is important to note that Kim (as indicated on its face) is assigned to "Dwonze Medical Instruments Co., LTD." Just as important, it is critical to note that Applicant's rejected application is also assigned to the same entity – namely – to "Dwonze Medical Instruments Co., LTD." See Applicant's assignment recorded at Reel 016875, Frames 0396, 0397, 0398 and 0399 corroborating the same.

Furthermore, (1) Applicant has perfected his priority claim to Korean Applications 10-2003-11732 (filed February 25, 2003), 10-2003-14033 (filed March 6, 2003) and 10-2003-32586 (filed May 22, 2003) by submitting certified English translations thereof on September 21, 2006; (2) the publication date of Kim is July 10, 2003; (3) the issue date of Kim is December 2, 2003, (4) Applicant's rejected Application has a U.S. filing date of February 9, 2004, and (5) Applicant's U.S. filing date (February 9, 2004) is within one year of his earliest claimed (and now perfected) priority date (February 25, 2003).

Also, Applicant's rejected claims are fully supported by the certified English translations of the priority documents submitted on September 21, 2006. Accordingly, Applicant is entitled to the benefit of the February 25, 2003, March 6, 2003, and May 22, 2003 priority dates, each of which predates the Kim July 10, 2003 publication date and the Kim December 2, 2003 issue date.

Accordingly, Kim cannot qualify as art against Applicant's specification under 35 U.S.C. § 102(a) because Kim did not publish (July 10, 2003) or did not issue (December 2, 2003) until

Serial No.: 10/773,242
Docket No.: 956-1001
Amendment dated January 23, 2007
Reply to the Office Action of September 27, 2006

after Applicant's priority dates (February 25, 2003, March 6, 2003, and May 22, 2003) to which Applicant is fully entitled.

Also, Kim cannot qualify as art against Applicant's specification under 35 U.S.C. § 102(b) because Applicant's U.S. filing date minus one year (i.e., February 9, 2003 = February 9, 2004 less one year) predates the Kim publication date (July 10, 2003) and the subsequent Kim issue date (December 2, 2003).

Thus, based on dates, Kim does not qualify as art against Applicant's specification under 35 U.S.C. §§ 102(a), or 102(b). Also, here are no issues regarding 35 U.S.C. § 102(c) or 102(d).¹

Accordingly, having ruled out 35 U.S.C. § 102(a), (b), (c) and (d), arguably at best, Kim could potentially qualify as art against Applicant's specification under 35 U.S.C. § 102(e), (f) or (g) based on the January 9, 2002 Kim U.S. filing date. However, under 35 U.S.C. § 103(c)(1), potential 102(e) art can be removed so long as the rejected application is pending after December 10, 2004² and if the applied reference is co-owned (or obligated to be co-owned) by the same entity:

[35 U.S.C. . § 103(c)(1) states] [s]ubject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the claimed invention was made, owned by the same person or subject to an obligation of assignment to the same person.
[(Emphasis added.)]

Here, (i) Applicant's U.S. application is still pending; (ii) Applicant's assignment was executed on January 26, 2004 in favor of "Dwonze Medical Instrument Co., Ltd."; and (iii) Applicant's priority applications were also filed in the name of "Dwonze Medical Instrument Co., Ltd." – which is the

¹ There are no issues regarding 35 U.S.C. § 102(d) in view of the timely U.S. filing (February 9, 2004) within one year of Applicant's earliest claimed priority date (February 25, 2003) as noted in item (5) above.

² Applicant's specification is still pending as of January 15, 2007.

Serial No.: 10/773,242
Docket No.: 956-1001
Amendment dated January 23, 2007
Reply to the Office Action of September 27, 2006

same co-ownership entity as the Kim assignee. Accordingly, Applicant satisfies each of the requirements of 35 U.S.C. § 103(c)(1) with respect to Kim.

That being the case, Kim is effectively removed as potential art against Applicant's claimed invention under 35 U.S.C. § 103(a) in view of the provisions of 35 U.S.C. § 103(c)(1)

Accordingly, with Kim removed as the sole primary reference, Applicant respectfully submits that none of the applied secondary references (Guitierrez, Grady, Lehmann, or Grant) can sustain the alleged obviousness rejections of record.

As such, Applicant respectfully requests reconsideration and withdrawal of each rejection of record under 35 U.S.C. § 103(a) in view of the operation of 35 U.S.C. § 103(c)(1).

New Claims

Applicant has introduced new claims 21-26 which are fully supported by the specification originally filed reciting various features (claim 21 – a collapsing folding frame, a mat disposed on the frame, and a therapy director movable in a longitudinal direction with respect to the mat; support for “longitudinal direction” is found in the specification at page 1, paragraph [0005] reciting a “length direction, to move forward and backward a therapy director 14”; claim 22 – the therapy director is longitudinally movable back and forth with respect to the mat; claim 33 – electric motor; claim 24 – roller or pressure bead; claim 25 – part of spinal corrector; claim 26 – foot plate).

As Kim does not qualify as potential art, new claims 21-16 are patentable over the cited references.

Characterization of cited references

The Office Action characterizes the disclosure of various references at page 7 of the Office Action. To the extent the characterization of their respective disclosures in the Office Action is not fully supported by the actual disclosures of U.S. Pat. Nos. 3,557,720; 5,009,170; 6,035,467; 6,705,234; 7,032,524; and 6,454,732, Applicant refutes any such characterization expressed in the Office Action. This also applies to each reference not accurately and precisely characterized during prosecution of Applicant's application.

Serial No.: 10/773,242
Docket No.: 956-1001
Amendment dated January 23, 2007
Reply to the Office Action of September 27, 2006

Conclusion

It is respectfully submitted that a full and complete response has been made to the outstanding Office Action and, as such, there being no other objections or rejections, this application is in condition for allowance, and a notice to this effect is earnestly solicited.

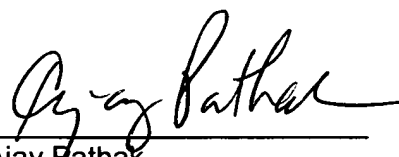
If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided below.

Please charge the excess claims fees (\$250) and the one-month extension of time fee (\$60) to our Deposit Account No. 50-2827. No other fees are believed to be due. However, if any further fees are required in connection with the filing of this amendment, please charge the same to our Deposit Account No. 50-2827, as needed.

Respectfully submitted,

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